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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/330,272	06/11/1999	RICHARD ZAFFINO	113304	9223

23838 7590 10/22/2003
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EXAMINER

VANDERPUYE, KENNETH N

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 10/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/330,272

Applicant(s)

ZAFFINO, RICHARD

Examiner

Kenneth N Vanderpuye

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 12-24 is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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DETAILED ACTION

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regards to claims 1 applicant claims in a subscriber-independent address this term is not defined in the specification and as such constitutes new matter. According to the specification the address the MSCs Ip address is used for transferring information as opposed to the IP address of the mobile. This does not make it a subscriber-independent address. A temporary address IP address can be assigned to any subscriber while it is

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in use. This makes it a subscriber independent address because it is not uniquely assigned to a particular subscriber.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the phrase "subscriber independent address" is not clearly defined in the specification. It is not clear if it is a temporary IP address which is not unique to any particular subscriber.

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Hartmaier. (6,034,753)

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With regards to claim 1, the admitted prior art teaches a method comprising the steps of:

receiving a registration request for the subscriber at a service node(Fig. 1, MSC)

What the admitted prior art fails to teach is determining at the service node an address addressable by an alternative network and associated with a wireless service(Tip address)

transferring information between the subscriber and the wireless service using the alternative network address(Tip address used for routing over data network). It would have been obvious to combine Hartmaier with the admitted prior art for the purpose enabling transmission over IP network. The motivation being to enable mobile user access to the internet.

Claim 2 is rejected because the MSC is capable of using the SS7 network or data network alternately. It is well known in the art that a data network can be connection-oriented or connectionless oriented.

Claim Rejections - 35 U.S.C. § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Billstrom et al.(5,590,133)

With regards to claim 1, the admitted prior art teaches a method comprising the steps of:

receiving a registration request for the subscriber at a service node(Fig. 1, MSC)

What the admitted prior art fails to teach is determining at the service node a subscriber-independent address(Billstrom, col. 21 line 8, IP address of the MSC) communicable with by an alternative network(Billstrom Fig. 2, MSC/VLR acts as a gateway to both a PSTN and the internet) and associated with a wireless service transferring information between the subscriber and the wireless and the information source or recipient using the determined address.(Billstrom Fig. 2, MSC wirelessly communicates via the MSC/VLR). As noted above Billstrom(col. 21 lines 6-13) teaches the

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determining of the IP address of the MSC. The IP address is used for routing purposes. It would have been obvious to combine Billstrom with the admitted prior art for the purpose of using the MSC IP address for routing purposes. The motivation being to enable mobile user access to the internet.

Claims 2, 4 are rejected because Billstrom suggests that the external network could be the internet or a PSPDN(Fig. 2)

Claim 3 is rejected because Billstrom teaches access to a PSTN or a PSPDN.(Fig. 2).

Claim 6 is rejected because based on Fig 2, wireless access to the internet.

Claim 7 is rejected because ANSI-41 and GSM are well known wireless access protocols. Billstrom teaches the GSM protocol. Official notice is taken that it would have been obvious to use ANSI-41 as an alternative wireless protocol.

Allowable Subject Matter

9. Claims 17-24 are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Vanderpuye whose telephone number is (703) 308-7828. The examiner can normally be reached on M-F from 6:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Olms, can be reached on (703) -305-4703. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.



KENNETH VANDERPUYE
PRIMARY EXAMINER

Kenneth Vanderpuye

October 19, 2003